

REMARKS

Entry of the foregoing Amendment prior to the next action is respectfully requested.

With entry of the Amendment Claims 1-19, 39, and 57-60 are now in the application. No claim has been allowed.

The previous Office Action rejected the claims under 35 U.S.C. 103(a) as supposedly being unpatentable over Robinson, *et al.*, in view of Bi, *et al.* It is believed that with entry of the foregoing amendment, the claims now recite distinguishing characteristics of the invention more clearly, and in a manner which must be considered in determining patentability.

More particularly, the Examiner admitted that Robinson does not expressly show steps to determine funding sources for a financial plan. The Examiner, however, believed that since such a difference was only found in the "non functional descriptive material" in the claim and "not functionally involved in the steps recited", that the descriptive material could not be considered capable of distinguishing the claimed invention from the prior art.

In response to this, Applicants have now positively recited this feature. Specifically, in the step of "selecting two or more financial products for comparison as funding sources for financial plan" is now the first clause of claim 1.

Similar amendments have been made to all other independent Claims 39, 57, and 58.

Furthermore, new Claim 60, which depends from Claim 1, positively recites the use of the comparison result to select one of the financial products as a funding source for a plan.

It is also believed that the Examiner's analysis of the *In re Gulack*, 703 F.2d 1381, 217 U.S.P.Q. 401 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 U.S.P.Q. 2d1031 (Fed. Cir. 1994) cases is in error. *In re Gulack* involved a rejection of the claims in view of printed matter. The holding of that case actually was that a functional relationship between the printed matter and the substrate was not required. Instead what is required are differences between the claims and the prior art sufficient to establish patentability. Indeed the bare presence or absence of a specific functional relationship is disposition of obviousness according to *Gulack*, 217 U.S.P.Q. at 404.

In re Lowry was a decision where the claims for a data processing system were held neither anticipated nor obvious in view of the prior art, since the claimed invention involved an organization of information and intrarelationships that was not found in the references.

In the present case, neither Robinson nor Bi suggest techniques for evaluating funding sources for different types of financial products. With regard to Robinson, the Examiner actually admits that it does not disclose how to select funding sources. In regard to Bi, that reference is merely matching buyers and sellers of physical objects. It does not evaluate funding sources for a financial plan. The Examiner states that Bi mentions “attributes”, but Bi is only discussing the attributes of a physical product such as its price, color, material, etc. (see Bi, at column 1, line 19-22). In contrast to this, the present invention’s use of attributes relates to the attributes of a financial product, and not price, color or material.

Furthermore, the claims as now amended require comparison of two different products of two different classes. For example, the Applicants’ invention permits comparison of the attributes of, for example, an insurance policy against a mutual fund. This particular aspect of the Applicants’ invention is now positively recited in Claim 1. Support for this amendment is found at least at page 3 of the specification where it was suggested that both life insurance and securities can be used as sources for funding a plan, and at page 6, where it furthermore is stated that attributes are populated with values for each product class. Most specifically, at page 12, an example is given for an insurance policy with attributes such as “cash flow” and other attributes such as “de-MEC provisions”. The attributes for a security (for example, a stock fund) performance rating (as explained at page 15 of the specification).

Additional amendments have been made to dependent Claims 7, 9, 10, 11, 12 and 13 to clarify that the attributes are selected by process steps.

Amendments have also been made to Claims 16-18 to clarify that the two financial products being compared are of two different types.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By 

David J. Thibodeau, Jr.

Registration No. 31,671

Telephone: (978) 341-0036

Facsimile: (978) 341-0136

Concord, MA 01742-9133

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